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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/755,855	01/12/2004	Stephen J. Lippard	MTV-061.01	8425

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EXAMINER

KOSAR, ANDREW D

ART UNIT PAPER NUMBER

1654

DATE MAILED: 05/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/755,855	Applicant(s) LIPPARD ET AL.	
	Examiner Andrew D. Kosar	Art Unit 1654	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 February 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above claim(s) 7,8,12-14,20,21,26,28,30,32,34 and 36-41 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,4,9 and 35 is/are rejected.
- 7) ☒ Claim(s) 2,6,11 and 15-34 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date. _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1-4, 6-9 and 11-42 are pending.

Response to Amendments/Arguments

Applicant's amendments and arguments filed February 27, 2006 are acknowledged and have been considered.

With regards to the restriction being improper, Applicant argues there would be no burden to search products and methods together. Applicant's arguments have been considered, but are not found persuasive. The examiner set forth a proper restriction, and showed that it would be an undue burden as the search of the compounds is based upon structure of each species and would not necessarily lead to the discovery of all pertinent art regard the use of the various species. Further, Applicant is reminded that the breadth of the originally presented claims which were restricted by the Examiner on September 15, 2005, were not limited to only steroids.

Accordingly, the restriction is still deemed proper and made FINAL.

Any rejection and/or objection not specifically addressed is herein withdrawn.

In view of Applicant's amendments to the claims, the teachings of Lippard (the therapeutic moiety being trifluoroacetic acid) are no longer applicable as prior art under 102(e) and/or 103(a), necessitating extension of the search. Accordingly, the examiner extended the search to the subgenus of claims **2, 6, 11 and 15-31 and 33**, which have been found to be free of the prior art, however they remain objected to for depending upon a rejected claim. The examiner further extended the search as set forth below.

New Grounds of Rejection/Objection

Claim 42 is objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim should depend from other claims in the alternative only. In the instant case, the claim recites ‘any of the compounds of claims 1-4, 6, 9...’ or ‘a combination thereof’, which is not referring to all claims in the alternative. See MPEP § 608.01(n). Accordingly, the claim has not been further treated on the merits.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3, 4 and 35 are rejected under 35 U.S.C. 102(b) as being anticipated by ALTMAN (J. Altman, et al. Inorg. Chem. (1991) 30, pages 4085-4088).

The instant claims are drawn generally to platinum compounds comprising 2 cis labile ligands and 1 or more steroids attached to the Pt core, directly or through a linker.

Altman teaches the compound *cis*-[PtCl₂(NH₃)(am)] (compound 2a, *Preparation of Complexes*, page 4085). 3-(2-aminoethoxy)estrone (am) is the therapeutic moiety, Cl are cis labile ligands.

Altman teaches that during the synthesis of the compound, it was triturated once with water (page 4085), and since water is pharmaceutically acceptable carrier and nothing precludes its use as such, said teaching meets the limitations of the compound in a pharmaceutically acceptable excipient.

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Claims 1, 3, 4 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by BERDAGUÉ (P. Berdagué, et al. J. Chem. Soc. Chem. Commun. (1994), pages 1589-1590).

The instant claims are presented *supra*. The claims are further drawn to the steroid being attached through a linker.

Berdagué teaches *cis*-[PtCl₂{PEt₂(O-chl)}₂] and *cis*-[PtCl₂{PPh₂(O-chl)}₂] (page 1589, *vida infra* "The ³¹P NMR spectra [of the compounds *cis*-[PtCl₂{PR₂(O-chl)}₂]]showed the presence of both the *cis* and *trans* isomers in the crude products which could be separated by column chromatography..." (page 1590). O-chl is cholesteryl, a steroid, PR₂ is a linker.

Allowable Subject Matter

Claims 2, 6, 11 and 15-31 and 33 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

This application contains **claims 7, 8, 12-14, 32, 34 and 36-41**, drawn to an invention and/or species nonelected with traverse on September 15, 2005 and affirmed in the reply filed


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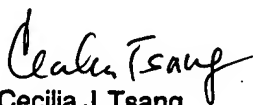
February 27, 2006. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew D. Kosar whose telephone number is (571)272-0913. The examiner can normally be reached on Monday - Friday 8am-430pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cecilia Tsang can be reached on (571)272-0562. The fax phone number for the organization where this application or proceeding is assigned is (571)273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Andrew D. Kosar, Ph.D.
Art Unit 1654


Cecilia J. Tsang
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